

REMARKS

Claims 1-24 are pending. Claims 1-4, 13-16, and 21-24 have been amended. Support for the amendments to the claims is found in paragraph [0012], [0013], and [0015]. Applicants respectfully submit that this amendment more clearly defines and emphasizes the claimed elements. No new matter is presented.

Claims 13-20 stand rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter. This rejection is respectfully traversed.

Claim 13 recites an apparatus. In the Office Action, the Examiner asserts that the “e-mail transmission apparatus” is not “embodied on a recordable medium” (see Office Action, page 2). Applicants respectfully submit that the Examiner’s rationale in rejecting claim 13 is incorrect. The rationale applies to computer program inventions claimed as products, not to physical apparatus. Claim 13 makes no mention of a “recordable medium” because the claim and its dependents are directed to physical and tangible apparatus. The claimed apparatus, similar to other categories of apparatus that are created by human innovation, takes on a physical form, and is therefore statutory subject matter as a “manufacture” or “machine” under 35 USC 101. Thus, applicants respectfully request that this rejection be withdrawn.

Since claims 14-20 depend from claim 13, the rejection of these claims also should be withdrawn.

Claims 1-4, 9, 11-16, and 18-24 stand rejected under 35 USC 102(b) as anticipated by Chang, U.S. 5,974,449. This rejection is respectfully traversed.

Claim 1, as amended, recites a recording medium, comprising, *inter alia*, “deciding a format of the data to be attached to the e-mail depending on the detected recipient’s domain name” and “attaching the formatted data to the e-mail as an attachment of the e-mail.”

In contrast, Chang does not disclose deciding on a format of the data to be attached to the e-mail depending on the detected recipient’s domain name. Nor does Chang disclose attaching the formatted data as an attachment to the e-mail.

In the Office Action, the Examiner asserts that Chang decides a format of the data to be attached to the e-mail depending on the detected recipient's domain name, as claimed, by citing to the following:

“At step 1414, a routing program 1540 or equivalent device determines whether the destination address, e.g., a destination phone number 1534, is within a local area 1542 supported by local server 1510, or within a non-local area 1544 supported by a remote server 1536 by using a routing table 1546.” (see Chang, col. 17, lines 40-45)

Applicants respectfully disagree. The portion of the reference that the Examiner has cited states nothing about data to be attached to an e-mail, much less deciding a format of the data to be attached to the e-mail depending on the detected recipient's domain name. Rather, the cited disclosure merely discloses determining the location of a destination address.

Chang's e-mail destination is either on a LAN (local area network) server or the destination is on a remote server. The server converts the attached file (for example, a digitalized audio message or WAV file; see col. 17, line 20). The server attaches the converted file disclosed in Chang into a voice mail to call a telephone to announce receipt of voicemail and waits until the voice message is listened to (see col. 17, lines 61 to col. 18, line 8). However, applicants submit that the server in Chang is not the same as what is recited in claim 1. Since the server in Chang is performing the conversion of the file, the claim limitations of deciding a format of the data to be attached to the e-mail depending on the detected recipient's domain name and attaching the formatted data as an attachment to the e-mail are not met.

Chang discloses that the file format for attachment is arbitrarily decided by the sender and the file is attached. The server converts file formats of the attached file into a voice message and reproduces it by telephone. If the message is directed to a remote server, the message is not converted at the LAN server. Instead, the remote server converts the attached file into a voice message and reproduces it by telephone. The claimed invention recites deciding a format of the

data to be attached to the e-mail depending on the detected recipient's domain name. The claimed invention may change the file format based upon information received.

Moreover, in deciding the formatting, Chang discloses that a person – a subscriber – to a messaging service sends an e-mail via a public telephone system. The subscriber in Chang's invention chooses whether the fax message will be received as a fax, as an email, or as a web page. The person decides whether the message received by a recipient will be received as a fax, as an e-mail, or as a web page (see Chang, col. 9, lines 27-33). Nowhere does Chang disclose any limitation that a recording medium decides what file format to attach data based upon recipient's domain name.

Chang does not disclose attaching the claimed formatted data as an attachment to the claimed e-mail. Instead, in Chang, the subscriber attaches the formatted data.

In view of the remarks above, applicants have demonstrated that the recording medium is not the same as the server disclosed in Chang.

In light of the deficiencies of Chang, applicants respectfully submit that claim 1 is not anticipated. Therefore, the rejection under 35 USC 102(b) is respectfully requested to be withdrawn. Accordingly, claim 1 is allowable.

Claims 5, 9, and 10 depend from claim 1. These claims are allowable at least due to their dependency from claim 1.

Claim 2, as amended, recites a recording medium, comprising, *inter alia*, “detecting a response time of the detected recipient's server,” “deciding a format of the data to be attached to the e-mail depending on the detected response time,” “formatting the data into the decided format so that the thus formatted data is attached to the e-mail, and “attaching the formatted data as an attachment to the e-mail.”

In contrast, Chang does not disclose detecting a response time of the detected recipient's server. Rather, in Chang, the PING program polls for a subscriber connection. The program scans for a network connection.

In the Office Action, the Examiner asserts that Chang discloses the “functionality of ping.” Applicants respectfully disagree with the Examiner’s assertion for the following reason.

The network disclosed in Chang scans for a network connection. The message is either sent within a LAN (local area network) or outside of the LAN in the disclosure. However, Chang does not disclose detecting the time it takes to receive a reply from a detected recipient’s server.

Claims 2-4 recite substantially similar subject matter as claim 1. Therefore, claims 2-4 are allowable.

Claims 6, 7, 8, and 17-19 are allowable at least due to their respective dependencies from independent claims 2-4.

Claim 13, as amended, recites “for attachment to the e-mail.” Applicants respectfully submit that this amendment is made to more clearly define the claimed invention. In particular, applicants’ are clarifying the attaching of the claimed formatted data to the claimed e-mail.

Claims 13 and 21-24 also recite substantially similar subject matter as recited in claim 1. Applicants respectfully request that the rejection of these claims under 35 USC 102(b) be withdrawn. Accordingly, these claims are allowable.

Claims 5-8 and 17 stand rejected under 35 USC 103(a) as unpatentable over Chang in view of Mai, U.S. Published Patent Application No. 2006/0242311.

These dependent claims all recite the limitations of claim 1, comprising, *inter alia*, deciding on the claimed data format; formatting the claimed data based on the deciding element of the claim; and sending the claimed e-mail and attachment.

As pointed out in the remarks above, Chang does not disclose a recording medium that decides on a data formatting for an e-mail attachment, attaches the data formatted, and sends out the e-mail and attachment.

Mai is drawn to “virtual multicasting” in a network that has not been upgraded to handle multicast transmissions (see Mai, paragraph [0008]). However, Mai fails to cure the defects of Chang.

Thus, Mai fails to disclose the aforementioned elements of the claimed invention. Further, neither Chang nor Mai, or any combination thereof, discloses all of the elements of the claimed invention. Therefore, the rejection is requested to be withdrawn.

Accordingly, claims 5-8 and 17 are allowable.

Claim 10 stands rejected under 35 USC 103(a) as unpatentable over Chang in view of Dunnion, U.S. Published Patent Application No. 2002/0199119.

Dunnion is drawn to a message being converted from MIME (Multipurpose Internet Mail Extensions) format into a proprietary format for efficient transmission (see paragraphs [0126], [0129], and [0168]). Dunnion discloses RSA, the original algorithm for signing and public key cryptography. (See paragraph [0162]).

Neither Chang nor Dunnion, or any combination thereof, discloses all of the elements of the claimed invention. Thus, it is requested that the rejection under 35 USC 103(a) be withdrawn.

Accordingly, claim 10 is allowable.

In view of the above, each of the claims in this application is in condition for allowance. Accordingly, applicants solicit early action in the form of a Notice of Allowance.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. **325772033000**.

Dated: November 7, 2007

Respectfully submitted,

By


Adam C. Lilling

Registration No. 60,272

Morrison & Foerster LLP
1650 Tysons Blvd, Suite 400
McLean, Virginia 22102
Telephone: (703) 760-7334
Facsimile: (703) 760-7777